



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 254,617	03 22 1999	JACQUES MALLET	ST96025-US	7283

29693 7590 01 28 2003

WILEY, REIN & FIELDING, LLP  
ATTN: PATENT ADMINISTRATION  
1776 K. STREET N.W.  
WASHINGTON, DC 20006

EXAMINER

FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/254,617

Applicant(s)

MALLET ET AL.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 64-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 64, 66, 70-91, 97-112 and 114-128 is/are allowed.
- 6) ☐ Claim(s) 65, 67-69, 92-96 and 113 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 22 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



Art Unit: 1632

### DETAILED ACTION

The amendment filed November 12, 2002 (Paper No. 19) has been entered. Claims 65, 67-69, and 75 have been amended. Claims 52-63 have been cancelled. Claims 76-128 have been newly added.

Accordingly, Claims 64-128 are pending in the instant application.

The following rejections are reiterated or newly applied and constitute the complete set of rejections being applied to the instant application. Rejections and objections not reiterated from the previous office action are hereby withdrawn.

#### *Priority Documents*

The certified English translation of the French priority application FR 96/11186, filed September 13, 1996 has been received (receipt date: December 21, 2001).

#### *Drawings*

The draftsman has objected to the drawings. See the PTO-948 attached to the Office Action of Paper No. 10 (mailed 5/23/01). Applicant is required to submit the drawing corrections within the time period set for response to this Office Action. Applicant may not request that any objection to the drawings be held in abeyance. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of this application.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



Art Unit: 1632

Claims 65, 67-69, 92-96, and 113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 65 is indefinite in its recitation of "an expression cassette sequence for the simultaneous expression of two different neurotrophic factors" because it is unclear if the expression cassette actually encodes the two different neurotrophic factors or if it encodes something else entirely.

Claims 67-69 remain indefinite in their recitation of "the adenovirus vectors are two replication defective recombinant adenoviruses" because an adenovirus vector is different from an adenovirus.

Claims 92-96 and 113 are indefinite in their recitation of "wherein each nucleic acid sequence encodes a different neurotrophic factor under the control of a single transcriptional promoter" because it is unclear if each coding sequence is linked to a separate promoter (albeit two copies of the same promoter) or if the coding sequences are in tandem with one promoter linked to the first coding sequence and no promoter linked to the second coding sequence. Furthermore, if only one promoter is present within the expression cassette, it is unclear if an IRES sequence is present between the two coding sequences. If no IRES is present, a fusion protein results. However, the specification does not describe a fusion protein.

### *Conclusion*

Claims 64, 66, 70-91, 97-112, and 114-128 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing



Art Unit: 1632

date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 10:00 AM to 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, William Phillips, whose telephone number is (703) 305-3482.

Anne-Marie Falk, Ph.D.

*Anne-Marie Falk*  
ANNE-MARIE FALK, PH.D.  
PRIMARY EXAMINER